UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,729	07/28/2000	Philip R. Krause		3338

35197 7590 04/07/2004

PHILIP R KRAUSE
9437 SEVEN LOCKS RD
BETHESDA, MD 20817

EXAMINER	
HONG, STEPHEN S	
ART UNIT	**PAPER NUMBER**
2178	7

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/628,729	KRAUSE, PHILIP R.	
	Examiner	Art Unit	
	Stephen S. Hong	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --

Period for R ply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

This action is responsive to communications: amendment filed on January 26, 2004 to the Application filed on 7/28/00 and IDS filed on 9/10/02.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims are directed to the feature of "determining the location on the computer display at which text is being read aloud by the reader." However, the specification fails to provide a "full, clear, concise" description of how the invention is made and enabled. The specification includes several phrases that speculate that voice recognition software can be used to determine the location at which text is being read aloud. (see "Description of Relevant Art" on page 5, line 10, "Computer-assisted methods can also be used to determine the location at which text is being read aloud; for example, the invention may use voice recognition software to control a cursor

location by causing the cursor to be located at the location in the text at which the reader is reading aloud.") It is not clear what is this voice recognition software is and also how the location detection is achieved using this software. The statement appears, at best, to be a speculation that something might work. This does not fulfill the requirements under 35 USC 112, first paragraph, in which the Applicant must provide a full concise description of the invention to enable any person skilled in the art to which it pertains. In fact, there is not evidence as to this invention was actually enabled and realized according to the specification. On page 21, in the Detailed Description section, the specification states, "In a preferred embodiment of a teleprompter device, the cursor position *may be* determined by voice recognition software or other computer-assisted devices that is used to identify the location within a text that is being read aloud." The description of the preferred embodiment must show how the invention is made, not how is "may be" created. Again, it is simply a speculation. Furthermore, there is still no teaching as to how the voice recognition software is used to detect and determine the location of the text being read aloud. Without the clear and concise description of how the different components (even if each component were well known), it would not have enabled any person skilled in the art to which it pertains to duplicate the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

> invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12 and 14-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tognazzini, U.S. Pat. No. 5,850,211, 12/98 in view of Schena et al., U.S. Pat. No. 6,166,723, 12/00.

As per independent claims 1-9, 11-12, 19 and 20, Tognazzini teaches the claimed limitations including:

> determining the location of the computer display at which text is being read by the reader (col.2, line 20, "integrating an eyetracker ...", line 29, "detecting a location on the display at which a user's eyes are looking"); and varying the rate at which text is presented in response to the result of the location –determining step (col.5, line 34, "The scroll speed is adjusted as a function of that position X.").

However, Tognazzini uses an eyetracking system to determine the location of the display being read by the user. Therefore, Tognazzini does not explicitly disclose limitation of "determining the location on the computer display at which text is being read aloud by the reader." Before addressing the limitation, an important distinction must be pointed out. That is, the claim does not point out that the location is determined using the reader's reading voice. In other words, the "determination of the location" can happen by any means, as long as the user is reading aloud while she is reading the document. In other words, if the reader of Tognazzini is reading aloud as she reads the text and the eyetracking determines the location of the reading position, that clearly meets the claimed features. Thus, it would have been obvious to a person of ordinary

skill in the art at the time of the invention to use Tognazzini's invention to read aloud, since it was an extremely well known practice to read aloud to other audiences, such as reading to children.

Tognazzini further discloses defining the neutral zone (see col.5, line 42, where "X=-9 to top" represents F3=0), deceleration zone and acceleration zone (col.5, line 56, "Equation (2) shows a non-linear function.." i.e., representing acceleration and deceleration); input to stop continued scrolling text (when "X=-9", for example.); input to cause text to scroll backward (FIG.5, "item 510 Scroll UP"); the rate of text scrolling being a function of the distance (col.5, line 33, "The scroll speed is adjusted as a function of that position X"); defining at least one zone graphically and at least one zone having differing attributes of background (FIG.4, item 460 "Different Background");

Nevertheless, to expedite the prosecution, examiner will address the limitation as that the location is determined using the reader's reading voice. As pointed out above, Tognazzini uses the eyetracking device to determine the position of the text being reading. However, Schena provides the following pertinent. Schena teaches the use of force feedback techniques to provide more natural controls in computing (col.2, lines 13+). Schena teaches that "'rate control' [is used for]... scrolling text in windows." Schena's preferred embodiment is by using an input mouse. However. Schena explicitly points out that "voice recognition" (col.9, line 40) can be used to provide the similar controls. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Schena into Tognazzini, since Schena

explicitly pointed out that using the voice recognition to control the text scrolling was extremely well known in the art at the time of the invention.

As per dependent claim 10, although Tognazzini does not explicit teach defining at least one zone by using a cursor, Tognazzini teaches that the zones are partitioned as rectangular regions in a window (see FIG.4). Furthermore, Tognazzini teaches that a windows based system was used in the implementation (col.5, line 14, "text object is stored within a window.."). Since it was well known to resize areas in the windows using a cursor control input means, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have used the well known resizing means, as Tognazzini suggested that the scroll rate controlling functions was not "set in stone" but was used definable (col.5, line 35+).

As per dependent claims 14-15, as explained with respect to claim 1 above, Schena teaches the use of the voice recognition to control the text scrolling. Further, given that teaching recognizing the reader's voice would have been obvious to a person ordinary skill in the art at the time of the invention, since a person of ordinary skill would have appreciated from the combination of Tognizzini and Schena that voice recognition would be used as the eyetracker to control the text scrolling.

As per dependent claims 16-17, although Tognizzini does not explicitly disclose that the text being read is supplied over the network, such feature would have been obvious to a person of ordinary skill in the art at the time of the invention as Tognizzini taught reading the electronic newspaper (col.5, lines 4-11), and it was extremely well known to supply electronic newspaper through internet.

As per dependent claim 18, Tognizzini teaches that the cursor is not presented on a display device (col.7, lines 1-63, as the eyetracker only tracks the position of the text without explicitly displaying the cursor).

Response to Arguments

Applicant's arguments filed 1/26/04 have been fully considered but they are not persuasive.

On page 9 of the amendment, Applicant asserts that "although the specification describes the potential use of voice recognition software to achieve the step of identifying the location at which text is being read aloud, neither the claims...not the specification require computer software to be used in this step." Applicant on page 10 continues by claiming that "the embodiment that is described is not necessarily one that uses computer controlled voice recognition software for the purpose of identifying the location at which text is being read, but is one in which a cursor control device is associated with the location at which text is being read."

The argument is not persuasive. The first paragraph of 25 USC 112 states "specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention." In other words, the Applicant is required to describe in the Specification, "the manner and process of making and using it, in such full, clear, concise, and exact terms."

Note that the page pointed out by the Applicant, i.e., page 21, lines 19-25 states "In a preferred embodiment of a teleprompter device, the cursor position may be determined by voice recognition software or other computer-assisted devices that is used to identify the location within a text that is being read aloud. Thus, a human user may also control a different type of cursor control devices to specify the location at which text is being read aloud." This is a clear evidence that the "full, clear, concise, and exact terms" of the description of the invention is not being provided. Note that although the paragraph explains the "Preferred embodiment" of the applicant's invention, it is replete with the speculative statements such as "may be" and "can be" done. Nowhere does not clearly describe what technology used in the Applicant's preferred embodiment to identify the location of the text that is being read aloud. In other words, the reader of the Applicant's specification would have no idea what the Applicant's "preferred embodiment" is, what technology is used in the preferred embodiment, and how the technology is applied in "reducing the invention to practice."

On page 12 and 13, Applicant argues that in 1994, "Dragon Systems software ...converted continuous spoken language into computer-readable text." Applicant further states that the "template training software must ...also determine the location n the template at which text is being read." Examiner disagrees. First, this is yet another speculative statements. The fact that the program compares the template with the voice of the user to train the voice pattern of the user does not automatically require that the program be able to locate within a text file where the user is reading aloud at a given time. Secondly, it is an attempt to enable the specification through the argument after

the specification has been completed. Nowhere in the specification does it mention this "Dragon System" and how it can possibly be interfaced in the Applicant's embodiment.

The Applicant's argument regarding the rejection under 35 USC 103 that the rejections are "overcome, because Tognazzini is irrelevant to and teaches away from the amended claims, and is thus irrelevant to a determination of obvious" is not persuasive. The prior combination disclose the invention at least as claimed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen S. Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday to Friday, 9:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Stephen Hong
Primary Examiner
Art Unit 2178
April 5, 2004